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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/459,138	12/10/99	JOHNSON	L 7040R

EXAMINER	
TOI, I.N, M	
ART UNIT	PAPER NUMBER
1733	10

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application N . 09/459,138	Applicant(s) JOHNSON ET AL.	
	Examiner Michael A. Tolin	Art Unit 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 August 2001* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *6 and 13-16* is/are allowed.

6)☒ Claim(s) *1-5,7-12 and 17-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-5, 7-12, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson'638 (US 5662638) in view of Kohler (US 2393541) and Heller (US 3574031).

The current Application is a CIP and the claims are not supported by any of the parent applications because the "electromagnetic field responsive member" language is not supported by the parent applications. Accordingly, the effective filing date of the current application is the actual filing date, 10 December 1999, and Johnson'638 therefore qualifies as prior art.

Johnson'638 teaches a method of making a flangeless seam by joining two members of a disposable article (Abstract). Johnson'638 teaches the use of joining means and a barrier member with the claimed configurations in the process of making the flangeless seam (Figs. 1-12). While Johnson'638 indicates any suitable joining means may be used (col. 12, lines 17-21), Johnson'638 does not recite joining means comprising an electromagnetic field responsive member and the claimed step of applying an electromagnetic field.

Kohler and Heller provide clear motivation for using an adhesive having susceptor particles therein, the susceptor particles being heated by an electromagnetic field to activate the adhesive. Kohler teaches that such adhesive systems may be heated to the exact temperature desired without danger of overheating or burning and that heating is limited to the bonding interface, thereby reducing the power requirements and avoiding damage to the substrates being bonded (page 1, col. 2, lines 35-50; page 2, col. 1, lines 40-50). Heller teaches that such adhesive systems are particularly suitable for bonding thin films where flexibility must be maintained, the benefits including rapid and uniform generation of heat over the entire surfaces to be bonded (col. 3, lines 20-52; col. 4, lines 15-50). It would have been obvious to one having ordinary skill in the art at the time of the invention to provide Johnson'638 with an adhesive/susceptor joining means and the claimed step of applying an electromagnetic field because one having ordinary skill in the art would have been motivated to obtain the above stated benefits taught by Kohler and Heller.

Regarding claims 2, 3, 7, and 9, Kohler and Heller indicate that the adhesive may be applied as a film or a liquid (Kohler, page 3, col. 1, lines 1-10; Heller, col. 4, lines 15-75, col. 6, lines 10-15). Integrally connecting the adhesive/susceptor to the film of Johnson'638 prior to folding is the expected manner of applying the adhesive/susceptor system. Furthermore, one of ordinary skill would have been expected to appreciate that applying a film after folding is an equivalent manner of providing an adhesive at the desired location. Only the expected result of providing an adhesive at the desired location has been achieved.

The limitation of pulling apart to form the flangeless seam is clearly taught by Johnson'638 (Figs. 3 and 4).

The claimed "secondary joining means" does not distinguish over the adhesive of the adhesive/susceptor system of Kohler or Heller.

Allowable Subject Matter

3. Claims 6 and 13-16 are allowed for the reasons provided on pages 5 and 6 of the office action mailed 05 June 2001.

Response to Arguments

4. Applicant's arguments filed 06 August 2001 have been fully considered but they are not persuasive.

Applicant provides two arguments directed to showing support for the claimed "electromagnetic field responsive member" in parent applications of the current continuation-in-part application. First, Applicant argues that support is found in parent application 08/541,377, now U.S. Patent No. 5,662,638. The '377 application discloses that heat bonding means and any other suitable joining means may be used for joining, but does not recite bonding with energy provided by an electromagnetic field to heat an electromagnetic field responsive member. Applicant points out that heat bonding with an electromagnetic field to heat an electromagnetic field responsive member was well known long before the filing date of the '377 application. Applicant argues that the '377 application has support for heat bonding with an electromagnetic field to heat an electromagnetic field responsive member because such is a well known heat bonding

method and the '377 application discloses that heat bonding means and any other suitable joining means may be used for joining.

This first argument is not found persuasive because the field of heat bonding includes a long list of possible methods. Heat bonding may be accomplished with shaped press platens, hot air, flexible pressing means, press platens having a shaped resistive heater, rollers, heating of one substrate before pressing against another, heating of both substrates and subsequently pressing them together, heating while pressing, heating after pressing, cooling with press platens while heating a bonding interface with an electrical resistance heating means, patterned adhesives or particular substrate structures in combination with generic press platens, various combinations of these methods, and many other methods. Additionally, an exhaustive list of heat bonding methods would be difficult or impossible to produce. Applicant appears to be arguing that it would have been obvious to use heat bonding with an electromagnetic field to heat an electromagnetic field responsive member in the '377 application. However, the test for supported subject matter is not obviousness, but rather whether the disclosure clearly conveys the claimed invention to one of ordinary skill in the art. The '377 application does not clearly convey a specific heat bonding method by reciting "heat bonding" because the list of heat bonding methods is too long and/or undefined to clearly convey any specific heat bonding method. See MPEP 2163-2163.06.

In the second argument, Applicant argues that support for the claimed "electromagnetic field responsive member" is found in parent application 09/034,763, now U.S. Patent No. 6,042,673. The '763 application discloses that bonding may be

accomplished with a conductive member which increases in temperature from eddy currents and hysteresis losses generated by an alternating electromagnetic field. However, this does not clearly convey the broader term "electromagnetic field responsive" because this broader term includes materials such as dielectrics which are heated without eddy currents or hysteresis losses. Additionally, the '763 application specifically defines conductive members as materials which increase in temperature from eddy currents and hysteresis losses generated by an alternating electromagnetic field. This does not clearly convey the broader term "electromagnetic field responsive" because this broader term includes materials such as dielectrics which are not conductive by this definition. The examiner finds no clear indication in the '763 application that any materials other than conductive members can be used in the disclosed electromagnetic field bonding method. Applicant appears to be arguing that it would have been obvious to bond with an electromagnetic field to heat a nonconductive electromagnetic field responsive member in the '763 application. However, the test for supported subject matter is not obviousness, but rather whether the disclosure clearly conveys the claimed invention to one of ordinary skill in the art. The examiner's position is that the '763 application does not clearly convey the currently claimed "electromagnetic field responsive member" language for the reasons stated above. See MPEP 2163-2163.06.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Tolin whose telephone number is (703) 305-6618. The examiner can normally be reached on Monday-Thursday 9:30am-8pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on (703) 308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

September 5, 2001

Michael A. Tolin
Patent Examiner